



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,759	10/24/2003	Steven M. Hoffberg	LIH 10.2	2471

10037 7590 04/29/2005

MILDE & HOFFBERG, LLP
10 BANK STREET
SUITE 460
WHITE PLAINS, NY 10606

EXAMINER

PATEL, RAMESH B

ART UNIT	PAPER NUMBER
----------	--------------

2121

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,759

Applicant(s)

HOFFBERG ET AL.

Examiner

Ramesh B. Patel

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 133-152 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 133-152 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 133-152 (renumbered claims from claims 156-175 under rule 37 CFR 1.126) are presented for examination. Claims 1-132 (since originally filed claims are 1-132, not 1-155 as stated in the preliminary amendment) have been canceled by preliminary amendment filed on 10/24/2003.

2. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Specification

Art Unit: 2121

3. The abstract of the disclosure is objected to because the newly submitted abstract with preliminary amendment on 10/24/2003 contains the terms "said", which are not appropriate for the language for the abstract. Correction is required. See MPEP § 608.01(b).

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Objections

6. Claims 156-175 are objected to because of the following informalities:

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Examiner has noticed that applicant has originally filed claims 1-132; however, the preliminary amendment filed on 10/24/2003, stated that "Please cancel claims 1-155." And "Please add new claims 156-175." In lines 1-2 on page 11.

Misnumbered claims 156-175 been renumbered 133-152 respectively.

Claim Rejections - 35 USC § 102

Art Unit: 2121

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 133-152 are rejected under 35 U.S.C. 102(e) as being anticipated by McCalley et al. (US Patent 5,191,410).

As to claim 132, McCalley teaches the invention including an apparatus for processing digital media signals, comprising: a digital processor for controlling said apparatus is taught as the system is provided for interactively and selectively communicating particular multimedia presentations to each of a plurality of subscribers (see, abstract and figure 2); a graphic user interface, having a wireless remote control providing a command input to said processor is taught as the system having a voice network interface and presentation player for graphic and voice data (see, abstract and figures 2-5 and col. 5, lines 14-36); a network interface for transmitting digital information from said processor to a remote location over a communication network, said information identifying a digital media signal for desired reproduction based on an input received from said remote control (see, figures 2-5 and col. 5, lines 31-66); and an output, controlled by, and local to said processor for presenting the desired digital media

Art Unit: 2121

signals for reproduction thereof (see, abstract and figures 2, 5 and 16-22 and col. 5, lines 18-25 and col. 6, line 62 to col. 7, line 24).

As to claims 134-137, McCalley teaches the apparatus wherein said network interface comprises Ethernet, a wireless local area network and employs digitally modulated communications over a telephone subscriber line and communicates information describing the content of the digital media signals (see, abstract and figure 2 and 16-22 and col. 12, lines 21-62).

As to claims 138-142, McCalley teaches the apparatus further comprising a digital media data storage system hosting digital media in a retrievable format wherein said digital media data storage system comprises an optical storage medium, a rewritable optical data storage medium, a magnetic data storage medium, a semiconductor memory data storage medium (see, figures 1-5 and col. 15, lines 30-68).

As to claims 143-145, McCalley teaches the apparatus wherein said processor comprises a manager for limiting reproduction of digital media signals according to a defined right of reproduction, and wherein said output presents digital media signals according to limits imposed by said manager and said processor controls said output to distort presentation of the digital media signals in dependence on said manager wherein said rights manager controls said output to prevent presentation of the digital media

Art Unit: 2121

signals in dependence on said manager (see, abstract and figures 2, 5 and 16-22 and col. 5, lines 18-25 and col. 6, line 62 to col. 7, line 24 and col. 15, lines 30-68).

As to claims 146-147, McCalley teaches the apparatus wherein said output presents the digital media signals as an analog media signal stream and a digital media signal stream (see, abstract and figures 1-5 and col. 15, lines 5-23).

As to claims 148-151, McCalley teaches the apparatus wherein said wireless remote control comprises a visual presenting data based on a communication from said processor and a graphic user interface input and wherein said network interface communicates electronic program guide information, wherein said remote control communicates through said network interface (see, figures 2, 5 and 16-22 and col. 5, lines 18-25 and col. 6, line 62 to col. 7, line 24).

As to claim 152, McCalley teaches the apparatus wherein said identifying a digital media signal for reproduction comprises an index reference (see, abstract and figures 2-5 and col. 6, line 62 to col. 7, line 24).


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2121

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh B. Patel whose telephone number is 571-272-3688. The examiner can normally be reached on M-Th; 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571-272-3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ramesh B. Patel 4/28/08 -
Primary Examiner
Art Unit 2121

rp